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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/764,609      | 01/17/2001  | Donald W. Malackowski | 29997/035A          | 7844             |

7590 01/26/2005  
J. William Frank, III  
McCracken & Frank  
200 W. Adams  
Suite 2150  
Chicago, IL 60606

EXAMINER

LEUBECKER, JOHN P

ART UNIT PAPER NUMBER

3739

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                               |                                    |  |
|------------------------------|-------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/764,609 | Applicant(s)<br>MALACKOWSKI ET AL. |  |
|                              | Examiner<br>John P. Leubecker | Art Unit<br>3739                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 and 80-106 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 80-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Specification***

1. The abstract of the disclosure is objected to because it does not adequately summarize the invention. Correction is required. See MPEP § 608.01(b). **This objection has been repeated from the previous Office Action since Applicant failed to address such.**

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-34 and 80-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al. (U.S. Pat. 5,617,857) for the reasons set forth in numbered paragraph 4 of the previous Office Action, paper number 07282004.

4. Claims 1-34 and 80-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al. in view of Acker et al. (U.S. Pat. 6,453,190) for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 07282004.

***Response to Arguments***

5. Applicant's arguments filed November 5, 2004 have been fully considered but they are not persuasive.

Applicant claims that "the ability to control the active optical elements as set out in the present claims was not believed possible in a real time manner". Since no evidence was

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provided showing that this was a common belief by all of those of ordinary skill in the art, it is assumed that this was only Applicant's belief. However Applicant's knowledge is not the standard in the technical field upon which all technical possibilities and impossibilities are measured.

Even so, Applicant's alleged impossibility rest on the "volume" of information transmitted between the navigation system and the tracking device in Chader et al. However, there is no indication in the Chader et al. disclosure, no description in Applicant's specification, nor any discussion in Applicant's arguments regarding the particular amount of information transmitted by Chader et al. and why current (at the time of the invention) wireless transmission systems could not handle such "abundance" of information.

Regarding claims 2, 24 and 30, the Examiner indeed fully understands the nature of this limitation. The Examiner's previous remarks regarding such claims were only addressing the changes made to those claims. The initial understanding and position taken with respect to these claims was maintained and thus was not reiterated. However, Applicant continues to describe Chader et al. while disregarding the obvious modification proposed by the Examiner. Chader et al. describes this signal querying operation (col.6, lines 45-60) with regard to a physical connection, such physical connection being eliminated by obviously making the communication wireless. There is no logical reason to believe that such querying operation would change with a change in the type of transmission of the information. Even though Applicant believes the Examiner has "made multiple changes to the device of Chader to reach the rejection of Claim 1 and then adds still more changes to reach the limitation of claim 2", the examiner has only made ONE change, all other limitations inherently fall in line with such change. Remember, we must

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give some credit to the level of ordinary skill. The Examiner will cite case law regarding this if Applicant really deems it necessary.

Regarding the Acker reference and the rejection base on such, and as previously pointed out at least two times, the fact that Acker et al. teaches a magnetic system is irrelevant to the particular teaching the Examiner is relying on in this reference. Clearly the Examiner is not suggesting the physical combination of any part of the Acker et al. system with the one of Chader et al. So why does Applicant continue to proffer such off-track arguments? Again, Acker et al. demonstrates the level of ordinary skill with respect to making the modification proposed by the Examiner (wireless instead of a hard-wired connection) and, more importantly, offers documented motivation for making such modification.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

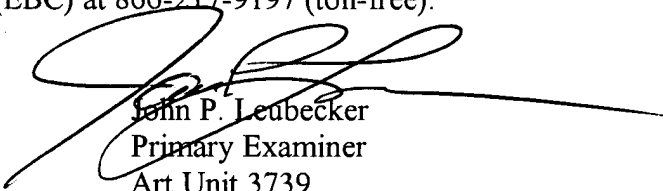
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl